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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,465	03/25/2004	Thierry Dupuis	066829-5101	6282
9629 7590 09/30/2008 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004				
EXAMINER				
HUYNH, NAM TRUNG				
ART UNIT		PAPER NUMBER		
2617				
MAIL DATE		DELIVERY MODE		
09/30/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/808,465

**Applicant(s)**

DUPUIS ET AL.

**Examiner**

NAM HUYNH

**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

This office action is in response to amendment filed on 6/6/2008. Of the previously presented claims 3-11, no amendments were made.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 3-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker (US 6,124,799) in view of Telia AB (WO 98/57511) (hereinafter Telia), and in further view of O'Connell et al. (US 6,052,581) (hereinafter O'Connell).

Regarding claim 9, Parker discloses a method and apparatus for locking communications devices. In the scope of the invention, a handset is programmed at the

time of manufacture (first locked) with an equipment identification number and a key (locking key), which is to be used in the computation of an authorization (unlocking) checkword preferably a value specific to the handset itself (columns 6-7, lines 52-67, 1-3). The handset initially is locked and may only be used for activation and emergency calls. To unlock or activate the handset, a user powers on the handset and the handset dials any number (establishing a communication by using a calling number) and routes subscriber identification information to a mobile telephone base station (figure 4, item 106). A customer service center (CSC) that can comprise of customer service personnel or an automated system uses a received equipment ID from the handset (transmitting to said calling number, an unlocking request using digital data comprising an identification number of the mobile telephone) to compute a valid  $M_{\text{handset}}$  (unlocking information) and sends this to the handset (transmitting unlocking information to mobile telephone) (figure 4, item 116). Once this value is received by the handset, it is stored in memory and is used for unlocking itself (unlocking using the received unlocking information) (figure 5, item 172).

The invention of Parker is not limited to the entity in which the mobile handset is locked to. Parker teaches that the handset may be electronically locked to a particular service provider, to a particular network, to a particular reseller, or even to an individual (column 4, lines 35-40). Furthermore Parker teaches that during the activation process, the handset receives from a central facility information capable of being used to transform the unique, secure values of handset into secure information specific to the controlling entity (such as the operator, network, reseller, etc) (column 7, lines 38-43).

However, Parker does not explicitly teach that the handset must be unlocked by the manufacturer. Telia discloses an unlocking method wherein a mobile telephone is locked to a specific SIM-card by the manufacturer (page 3 lines 15-21). In operation of the invention, a user must register a subscription at a reseller, then the manufacturer (AHS) checks whether the customer has signed a valid subscription management agreement, then if validated, the manufacturer then transmits unlocking information to the mobile telephone in order for a user to use other SIM-cards (page 4, lines 3-25). Therefore it would have been obvious to one of ordinary skill in the art to modify the invention of Parker to allow the handset to be locked by the manufacturer, as taught by Telia, in order to enhance protection in provisioning the handset by eliminating the need to distribute keys to the carrier.

The combination of Parker and Telia does not explicitly disclose that the user establishes a communication by using a calling number relating to the manufacturer of the handset in order to perform the unlocking function. O'Connell teaches calling a free phone telephone number (calling number) run by the phone manufacturer in order to request activation of a feature (column 9, lines 25-37). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the unlocking method taught in the combination of Parker and Telia to include calling a number relating to the manufacturer, as taught by O'Connell, in order to properly contact the controlling entity to which the handset is locked

Regarding claims 10, 11, 3, and 4, Parker teaches contacting customer service personnel (contacting user's operator) (column 8, lines 45-48) and Telia teaches that

the AHS (manufacturer) checks whether the customer has a valid subscription agreement (verify if the user is entitled to unlocking) (page 4, lines 3-4).

Regarding claim 11, Parker discloses that the HLR identifies the subscriber and routes the call (establish communication) to the CSC (figure 4, item 110).

Regarding claims 5-7, Telia teaches that the AHS verify's that the mobile telephone is eligible of being unlocked then instructs (send a confirmation message) to components of a wireless network to transmit a special message with unlocking commands (indications of operations) (page 4 lines 3-25).

Regarding claim 8, O'Connell teaches that a user would call a number relating to the manufacturer and therefore renders (transmitting data on a speech channel).

### ***Response to Arguments***

4. Applicant's arguments filed 6/6/2008 have been fully considered but they are not persuasive.

Applicant asserts that O'Connell does not teach the limitation of claim 9 recited "the user, through said mobile telephone, establishing a communication by using a calling number relating to the manufacturer". O'Connell teaches a user calling the telephone number of a **manufacturer** (emphasis added) to activate a feature of the phone (column 9, lines 25-37), thus teaching that a user calls the number relating to the manufacturer. Applicant also asserts that O'Connell does not teach the limitation recited "said mobile phone proceeding itself to unlocking using the received unlocking information". O'Connell was cited to specifically teach a user contacting the

manufacturer of a phone for activation and does not teach this limitation, since the invention pertains to activating features on a phone. However, this limitation is taught by Parker where the handset proceeds to unlock itself after receiving  $M_{\text{handset}}$ , or the unlocking information (column 8, lines 60-67; column 9, lines 1-10; column 11, lines 8-16). The Examiner interprets the combination as a user of the invention of Parker would establish a call using a number relating to the manufacturer, as taught by O'Connell. Then the handset would be unlocked as taught by Parker. Therefore for these reasons and the reasons set forth above, the rejection of claim 9 has been maintained.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NAM HUYNH whose telephone number is (571)272-5970. The examiner can normally be reached on 8 a.m.-5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Eng/  
Supervisory Patent Examiner, Art Unit 2617

NTH  
9/25/08